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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

BUCZINSKI, S

ART UNIT

PAPER NUMBER

3662

DATE MAILED:

07/31/01

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 16 JULY 2001.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-59 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 11
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit 3662

1. Claims 1-59 are objected in that the form of the amendments to the present claims is acceptable as a "marked-up copy" only. A "clean copy" is required showing the final disposition of the claims is required whereby claims 1-8 show with respect to the original patented claims:

-deletions by bracketing

-additions by underlining

As to new claims 9-59 all text must be underlined once with no bracketing, except as above for the purposes of conveniently indicating changes from action to action in the marked-up copy.

2. The reference to McDaniel submitted 17 February 2000 has been made of record. Reference material filed on PTO-1449 16 July 2001 has been made of record.

3. Claims 5, 6, and 56-58 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5, line 1, refers to a "video cassette recorder" in claim 4 for which there is no antecedent basis. Parent claim 4 uses the terminology "video tape recorder" instead on line 1.

Claim 56 appears to have meant to state on the last line: --unlocking means--, and thus must be changed.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the

Art Unit 3662

same person.

6. Claims 9-19 and 29-39 as well as newly submitted 40-58 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over either Bonneau et al or Amano et al as of record.

In its decision in the parent application the Board stated that Bonneau et al was different from the claims before it (and the present similar claims) in that Bonneau et al did not teach "system power standby" or clearing the existing code each time. It did find that displaying prompts and the key code on the screen to have been obvious. Thus Applicant's argument for these claims based on there being allegedly no reception of the carrier frequency is not tenable. The same argument was not supported by the Board in the original claims, since Bonneau et al's system includes circuitry that in some part must receive a signal that is rejected by the phase locked loop selectivity.


Any future argument that the source is from a "recording medium" or constitutes "audio" is likewise met by the probable video and audio signal source in Bonneau et al which is derived at some point from a studio recording medium or would have been obvious to have been derived from such. This is in contrast the claims 1-7 which involve a recorder operation.

Similar arguments can be made for Amano. The Board stated that the only differences were that Amano et al had no system power standby and no storing of the code if the system is not locked. As above the present claims are not so distinguishable.

7. Claims 9-19 and 29-58 are rejected as being drawn to recaptured subject matter. Note Pannu v. Storz Instruments, Inc., attached.

Arguments present in the Brief in the original application for claim 8, argued that the "power standby" mode was the point of novelty in that claim that did not otherwise include the cassette recorder control. To have deleted both features from the present claims is considered to be recapture of surrendered subject matter.

8. Any inquiry concerning this communication should be directed to Stephen C. Buczinski at telephone number (703) 305-1835.


STEPHEN C. BUCZINSKI
PRIMARY EXAMINER

Serial Number 09/506,288

4

Art Unit 3662

United States Court of Appeals for the Federal Circuit

00-1482

JASWANT S. PANNU and JASWANT S. PANNU, M.D., P.A.,

Plaintiffs-Appellants,

v.

STORZ INSTRUMENTS, INC.,

Defendant-Appellee.

Michael C. Cesarano, Akerman, Senterfitt & Eidson, P.A., of Miami, Florida, argued for plaintiffs-appellants.

Edward W. Remus, McAndrews, Held & Malloy, Ltd., of Chicago, Illinois, argued for defendant-appellee. With him on the brief was Jonathan R. Sick. Of counsel on the brief were Craig E. Larson, Bausch & Lomb, Incorporated, of Rochester, New York; and Rita D. Vacca, Bausch & Lomb Surgical, Inc., of St. Louis, Missouri.

Appealed from: United States District Court for the Southern District of Florida

Judge William P. Dimitrouleas

United States Court of Appeals for the Federal Circuit

00-1482

JASWANT S. PANNU and JASWANT S. PANNU, M.D., P.A.,

Plaintiffs-Appellants,

v.

STORZ INSTRUMENTS, INC.,

Defendant-Appellee.

DECIDED: July 25, 2001

Before MAYER, Chief Judge, FRIEDMAN, Senior Circuit Judge, and RADER, Circuit Judge.

MAYER, Chief Judge.

Jaswant S. Pannu and Jaswant S. Pannu, M.D., P.A. (collectively Pannu) appeal the judgment of the United States District Court for the Southern District of Florida, Pannu v. Storz Instruments, Inc., 106 F. Supp. 2d 1304 (S.D. Fla. 2000), granting summary judgment for Storz Instruments, Inc. (Storz) that U.S. Patent No. Re 32,525 is invalid under 35 U.S.C. § 251, the recapture rule. Because the reissued patent improperly broadened claims in a manner directly pertinent to subject matter surrendered during prosecution, we affirm.

Background

In 1980, Pannu filed a patent application for an artificial intraocular lens, S/N 136,243 ('243 application). An intraocular lens is an artificial plastic lens that may be implanted in an eye to replace a natural lens. The '243 application disclosed a round lens called an "optic" that focuses light on the retina, and two or more elements called "haptics" that are attached to the optic and contact internal tissue in the eye for the purpose of positioning and securing the optic. The haptics in Pannu's application included "snag resistant" discs at the end. In 1981, Pannu filed a continuation-in-part application, S/N 261,953 ('953 application), based on the original '243 application. The '953 application added new matter, claiming a lens in which the haptics are "integrally molded" to the

Art Unit 3662

lens body, and the lens could be placed in either the anterior or posterior chamber of the eye.*

Independent claim 1 of the '953 application reads as follows:

A posterior chamber intraocular lens comprising:

a lens having a width and a thickness;

a retention loop including a flexible strand having a width and a thickness and such strand is joined at one end to the lens and has an opposite free end;

and a snag resistant disc joined to the flexible strand's free end;

said snag resistant disc having a width which is at least 3 times greater than the thickness of the disc, at least 3 times greater than the width of the flexible strand, and at least 1/5 as great as the width of the lens for smoothly guiding the free end of the flexible strand across an inner edge of an iris when moving said strand into and out of a posterior chamber of an eye;

said snag resistant disc lying in a plane sufficiently close to a plane of the lens so that both the disc and lens can fit into a posterior chamber behind an eye's iris.

The examiner rejected claims 1-14 as obvious under 35 U.S.C. § 103 in light of four prior art references: U.S. Patent No. 4,159,546 (Shearing patent), a publication showing the "Lindstrom Centrex" lens, U.S. Patent No. 4,249,271 (Poler patent), and U.S. Patent No. 4,092,743 (Kelman patent). In response, Pannu filed a supplemental amendment that cancelled claims 1-7 and 10-14, added new claims 16-22, and modified claims 8 and 9 to be dependent upon claim 16. Independent claim 16 reads as follows:

An intraocular lens comprising:

a lens body;

at least two flexible positioning and supporting elements integrally formed with said lens body and extending from the periphery of said lens body;

said elements defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference; and

snag resistant means integrally formed on the free end of said elements for smoothly guiding the lens across eye tissue when implanting the lens.

Pannu raised six arguments for the patentability of claim 16 over the four prior art references, including the distinction of "a continuous substantially circular arc having a diameter greater than the diameter of the lens body . . . which significantly enhance the

* The eye is considered to have two chambers separated by the iris. The anterior chamber lies between the back surface of the cornea and front surface of the iris. Attorneys' Dictionary of Medicine and Word Finder A-280 (1995). The posterior chamber is the space between the back surface of the iris and the front surface of the crystalline lens. Id. at P-280.

Art Unit 3662

easy insertibility of applicant's lens and significantly reduce any possibility of snagging delicate eye tissue." The examiner accepted Pannu's arguments, and allowed claim 16 subject to minor amendments to set forth precisely the structural details of the haptics.

Claim 16 issued as claim 1 of U.S. Patent No. 4,436,855 ('855 patent) and reads as follows:

An intraocular lens comprising:

a lens body,

at least two spaced flexible positioning and supporting elements integrally formed with said lens body as a one piece construction and extending radially outward from the periphery of said lens body,

said elements defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference and terminating in a free end spaced from said periphery; and

snag resistant means integrally formed on the free end of said elements for smoothly guiding and positioning the lens across contacted eye tissue when implanting the lens,

said snag resistant means having an uninterrupted continuously smoothly curved outer periphery which merges with said free end and is substantially greater in size than the width of said flexible elements.

In 1985, Pannu filed an application for reissue of the '855 patent. The supplemental reissue oath stated that Pannu "unduly and without deceptive intent narrowed the claims beyond what was necessitated by the applied prior art by describing the shape of the outwardly extending elements as defining 'a continuous, substantially circular arc having a diameter greater than the diameter of the lens body.'" The examiner allowed Pannu to delete "defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference and terminating in a free end" from claim 1. However, the examiner required Pannu to insert additional limitations into the last section of the claim. The last section of claim 1 reads as follows with italics indicating additions and bracketing indicating deletions:

said snag resistant means having an uninterrupted, continuously smoothly curved outer periphery which merges with said free end and is [substantially] at least three times greater in [size] width than the width of said flexible elements, said snag resistant elements and said positioning and supporting elements being substantially coplanar.

The '855 patent reissued as U.S. Patent No. Re 32,525 ('525 reissue).

Pannu filed suit against Storz, alleging that intraocular lenses sold by Storz infringed the '525 reissue. Storz filed a counterclaim seeking a declaratory judgment of patent invalidity, and moved for summary judgment that the '525 reissue improperly recaptures subject matter Pannu surrendered in obtaining allowance of claim 1 of the '855 patent. The court granted Storz's motion for summary judgment of invalidity and Pannu appeals.

Discussion

"We review a district court's grant of summary judgment de novo." Vanmoor v. Wal-Mart Stores, Inc., 201 F.3d 1363,

Art Unit 3662

1365, 53 USPQ2d 1377, 1378 (Fed. Cir. 2000). Determining whether the claims of a reissued patent violate 35 U.S.C. § 251 is a question of law, which we review de novo. In re Clement, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1163 (Fed. Cir. 1997); Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993). This legal conclusion can involve underlying findings of fact, which are reviewed for substantial evidence. Hester Indus., Inc. v. Stein, Inc., 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998); Mentor, 998 F.2d at 994, 27 USPQ2d at 1524 (citing Ball Corp. v. United States, 729 F.2d 1429, 1439, 221 USPQ 289, 297 (Fed. Cir. 1984)). However, summary judgment is appropriate only when there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. Vanmoor, 201 F.3d at 1365, 53 USPQ2d at 1378. The underlying facts in this case are taken directly from the prosecution file histories and the claims of the '855 patent and the '525 reissue, and are not disputed. See Hester, 142 F.3d at 1484, 46 USPQ2d at 1651. Claim construction is a purely legal question, Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1456, 46 USPQ2d 1169, 1174 (Fed. Cir. 1998) (en banc), and therefore, comparison of the claims of the '855 patent and the '525 reissue is a purely legal question appropriate for summary judgment, Westvaco Corp. v. Int'l Paper Co., 991 F.2d 735, 741, 26 USPQ2d 1353, 1358 (Fed. Cir. 1993) ("A determination of whether the scope of a reissue claim is identical with the scope of the original claim is a question of law, which we review de novo.").

The recapture rule "prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims." Clement, 131 F.3d at 1468, 45 USPQ2d at 1164. Reissued claims that are broader than the original patent's claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible. Id. (quoting Mentor, 998 F.2d at 996, 27 USPQ2d at 1525). Application of the recapture rule is a three-step process. The first step is to "determine whether and in what 'aspect' the reissue claims are broader than the patent claims." Id. "The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter." Id. Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. Hester, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; Clement, 131 F.3d at 1470, 45 USPQ2d at 1165.

With respect to the shape of the haptics, claim 1 of the '525 reissue is broader than claim 1 of the original '855 patent. Claim 1 of the '855 patent limited the haptics to "a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference." Claim 1 of the '525 reissue eliminated this limitation on the shape of the haptics. "A reissue claim that does not include a limitation present in the original patent claims is broader in that respect." Hester, 142 F.3d at 1480, 46 USPQ2d at 1648. In addition, Pannu's reissue oath admitted that he unnecessarily narrowed the scope of the claim with respect to the shape of the haptics. He stated that "the [haptics] may actually be of any shape as long as the elements terminate in a free end having snag resistant means as now recited in claim 1." Correction of Pannu's unnecessary narrowing of

Art Unit 3662

claim 1 must involve a corresponding broadening of the reissued claim.

Pannu argues that even if the reissued claim is broader, it did not relate to subject matter surrendered during prosecution. This argument is without merit. As originally filed, none of the claims in the '953 application limited the shape of the haptics. The examiner rejected claims 1-14 as obvious. In response to the rejection, Pannu filed a supplemental amendment canceling claim 1 and adding new independent claim 16. Claim 16 described the haptics as "defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference." Pannu argued to the examiner, "no such particular shape is disclosed by the lenses of either Shearing or Lindstrom. In fact, Shearing teaches away from the concept of a continuous substantially circular arc supporting strand . . . [and] the Lindstrom lens illustrates a supporting strand with a somewhat irregular, elliptical shape." The addition of the "continuous, substantially circular arc" limitation to claim 16 and the statements made by Pannu to the examiner during prosecution of the '855 patent limited the claim to exclude an interpretation that did not include a continuous, substantially circular arc. See Southwall Techs., Inc. v. Cardinal AG Co., 54 F.3d 1570, 1576, 34 USPQ2d 1673, 1676 (1995). The shape of the haptics was broadened during reissue and was the same subject matter that was surrendered during prosecution.

Pannu argues, however, that because the reissued claims were materially narrowed in other respects, the '525 reissue avoids the recapture rule. See Hester, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; Clement, 131 F.3d at 1470, 45 USPQ2d at 1165; Mentor, 998 F.2d at 996, 27 USPQ2d at 1525. Instead of being "substantially greater" than the width of the haptics, the snag resistant means must now be "at least three times greater" than the width of the haptics. In addition, the snag resistant means must now be "substantially coplanar" with the haptics. Pannu argues that both modifications relate to the configuration of the haptics, and therefore, what is gained by the elimination of one limitation is given up by the addition of the other limitations.

The "continuous, substantially circular arc" limitation related to the shape of the haptics. The narrowing aspect of the claim on reissue, however, was not related to the shape of the haptics, but rather the positioning and dimensions of the snag resistant means. Therefore, the reissued claims were not narrowed in any material respect compared with their broadening. Furthermore, "if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution this flexibility of analysis is eliminated, for the prosecution history establishes the substantiality of the change and estops its recapture." Anderson v. Int'l Eng'g & Mfg., Inc., 160 F.3d 1345, 1349, 48 USPQ2d 1631, 1634 (Fed. Cir. 1998); see also Mentor, 998 F.2d at 996, 27 USPQ2d at 1525 ("[I]n this case, the reissue claims are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution. Mentor thus attempted to reclaim what it earlier gave up."). In prosecuting the '855 patent, Pannu specifically limited the shape of the haptics to a "continuous, substantially circular arc." On reissue, he is estopped from attempting to

Serial Number 09/506,288

10

Art Unit 3662

recapture the precise limitation he added to overcome prior art rejections.

Conclusion

Accordingly, we affirm the judgment of the United States District Court for the Southern District of Florida.

AFFIRMED